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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In the Matter of Application Serial No. 76/205,157
Published in the Official Gazette of June 25, 2002

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U.S. Patent & TMO/tc/TM Mail Rcpt. Dt. #57



07-25-2002

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TERRA NETWORKS, S.A.,

Opposer,

-against-

NIPPON DENKI KABUSHIKI KAISHA,
d/b/a NEC CORPORATION,

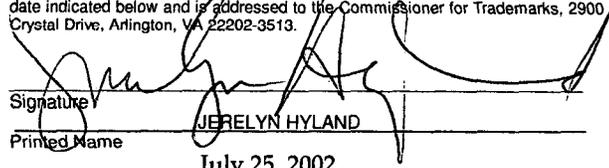
Applicant.
----- X

Opposition No.:

Commissioner for Trademarks
2900 Crystal Drive
Arlington, VA 22202-3513

Attn: BOX TTAB FEE

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I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10 on the date indicated below and is addressed to the Commissioner for Trademarks, 2900 Crystal Drive, Arlington, VA 22202-3513.

Signature: 
Printed Name: JERELYN HYLAND
Date: July 25, 2002

Date: 02 AUG 26 AM 8:46
TRADE MARK TRIAL AND APPEAL BOARD

NOTICE OF OPPOSITION

TERRA NETWORKS, S.A., a Spanish corporation, with a place of business located at Via de Las Dos Castillas, 33/Complejo, Edificio 1-Primera Planta, 28224 Pozuelo de Alarcon (Madrid), Spain [hereinafter "Opposer"], believes that it will be damaged by registration of the trade - and service mark "TERRASURFIN", as shown in Application Serial No. 76/205,157, filed February 5, 2001, and hereby opposes same.

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As grounds for opposition, it is alleged that:

1. Applicant has filed an application in the United States Patent and Trademark Office, Serial No. 76/205,157, filed February 5, 2001, for registration of the trade - and service mark "TERRASURFIN" on the Principal Register in respect of "Computer search engine software for local and global computer information networks; computer software for use in searching, retrieving, accessing to and editing the data information stored in electronic computers and computer peripherals interconnected with the local and global computer information networks and for use in providing users/clients with the edited data information via the aforesaid networks; computer software for use in creating three dimensional map, in Int'l. Class 9; Providing multiple-user access to the local and global computer information networks, in Int'l. Class 38; Provision of information in the fields of culture, education, art, music, sports, entertainment and amusement via local and global computer information networks, in Int'l. Class 41; and Computer services, namely, providing information featuring a wide variety of topics of general interest to the consuming public, businesses, and private institutions via local and global computer information networks", in Int'l. Class 42.

2. Upon information and belief, Applicant did not use its alleged mark "TERRASURFIN" prior to the filing date of its application for registration.

3. Opposer is the owner of the trade- and service mark "TERRA" and has applied to register said mark in International Class 38 in the United States Patent and Trademark Office, Application Serial No. 75/641,855, filed February 12, 1999, in respect of the following services:

Telecommunication services, namely, electronic transmission of data, images and documents via computer terminals; electronic mail services; facsimile transmission; providing telecommunication connections to global computer networks.

4. Opposer has also filed the following U.S. service mark applications in International

Class 38:

TERRA.COM, Ser. No. 75/980,150, filed April 1, 1999, for “telecommunication services, namely, electronic transmission of data, images, and documents via computer terminals; electronic mail services; facsimile transmission; providing telecommunication connections to global computer networks”

TERRA LIBRE & Design, Ser. No. 75/923,855, filed February 22, 2000, for “telecommunication services, namely, providing of multiple user access to a global computer information network”

TERRATEL, Ser. No. 75/921,809, filed February 16, 2000, for “telecommunication services, namely, providing multiple user access to a global computer information network”

TERRA A WORLD THAT REVOLVES AROUND YOU, Ser. No. 75/923,854, filed February 22, 2000, for “telecommunication services, namely, providing multiple user access to a global computer information network”

Instan Terra, Ser. No. 76/031,607, filed April 21, 2000, for “telecommunications services comprising the providing of multiple user access to a global computer information network (Internet/intranet) for the transfer and dissemination of any type of information, image or sound”

PLANETA TERRA, Ser. No. 75/921,802, filed February 16, 2000, for “telecommunication services, namely, providing multiple user access to a global computer information network”

5. Opposer has applied to register the word “TERRA” for a wide range of goods and services in Int’l. Classes 9 (including computers, computer software used for telecommunications, and products used in communications and telecommunications), 35 (including commercial information and directory services, and the dissemination of advertising for others via an online

electronic communications network) and 42 (including computer programming for others, providing information in the field of technology, website design services for others, and configuration and installation of computer software for others), Ser. No. 75/837,362, filed November 1, 1999, and opposer has applied to register "TERRA & DESIGN" for a wider range of goods and services in Int'l. Classes 1, 3, 5, 9 (including computers, computer programs used to provide database directories and for database management in the field of financial, economical, telecommunications and banking matters, and communications products), 12, 14, 16, 18, 25, 28, 29, 35 (including commercial information and directory services, and the dissemination of advertising for others via an online electronic communications network), 36, 37, 38 (including telecommunication services comprising the providing of multiple user access to a global computer information network), 39, 40, 41 (including providing entertainment information) and 42 (including providing information in the field of technology, website design services for others, and configuration and installation of computer software for others), Ser. No. 75/837,364, filed November 1, 1999.

6. Opposer is the owner of the following service marks which are registered on the Principal Register of the United States Patent and Trademark Office:

TERRANET, No. 1,941,127, dated December 12, 1995 - for "providing multiple-user access to a global computer information network for the transfer and dissemination of a wide range of information" (Int'l. Cl. 42)

TERRAONLINE, No. 2,346,490, dated May 2, 2000 - for "computer database management; business management consulting in the field of the global computer network and internal computer networks" (Int'l. Cl. 35); transmission of voice, data and documents via computer terminals, fax machines, telephones, televisions, and modems" (Int'l. Cl. 38); computer programming for others; computer consultation; design of websites for others" (Int'l. Cl. 42).

Said registrations are valid and subsisting, and opposer hereby gives notice, in accordance with Trademark Rule 2.122(d)(2), that it will rely thereon as evidence on its behalf in this proceeding, and

status copies thereof showing present title will be introduced into evidence during opposer's testimony period.

7. Opposer uses the domain name "terra.com" as the address for its well-known web portal site, which provides a wide variety of news, information, entertainment and services to the public. It has used said domain name since prior to the filing date of the opposed application and prior to any use of Applicant's alleged mark in the U.S.A., or in commerce, until the present date, and such use by Opposer has been continuous and substantial.

8. The term "Terra" is the dominant part of Opposer's trade name, and said trade name has been used in commerce since prior to the filing date of the opposed application and prior to any use of Applicant's alleged mark in the U.S.A., or in commerce, until the present date, and such use by Opposer has been continuous and substantial.

9. Upon information and belief, Opposer has used its aforementioned trade- and service marks, trade name and domain name in commerce since prior to the filing date of the opposed application and prior to any use of Applicant's alleged mark in the U.S.A., or in commerce, until the present date, and Opposer's aforementioned trade symbols became well-known and recognized as symbols of Opposer's goodwill prior to any use of the word "TERRASURFIN" by the applicant, and prior to the filing date of any application for registration of said word.

10. Inherently, and as a result of such use, Opposer's pleaded trade symbols possess a high degree of distinctiveness and represent extremely valuable assets and symbols of the goodwill of its business, and are well-known and recognized by the public as identifying high quality goods and services which have their source of origin with Opposer, and as distinguishing such goods and services from those of others.

11. As noted hereinabove, Opposer is the prior user of the domain name "terra.com" as the address for its World Wide Web "portal" site. The applicant's alleged mark "TERRASURFIN" is likely to be associated with the opposer's web site since the mark suggests the act or process of "surfing" on the "TERRA" web site.

12. Applicant's alleged mark "TERRASURFIN" is dominated by the word "TERRA", and said mark is confusingly similar to Opposer's pleaded trade symbols in sound, appearance and/or commercial impression.

13. The respective goods or services of the Opposer and the Applicant are the same, closely related, or complementary, and would be marketed through the same channels of trade for sale to the same general class of purchasers.

14. Applicant's alleged mark is calculated or likely to cause confusion or mistake or deception of purchasers as to the respective marks, trade names, domain names and goods or services of the Opposer and the Applicant, and also as to the source of origin or sponsorship of the goods or services for which such trade symbols are used, or are intended to be used.

15. Applicant's alleged mark is calculated or likely to cause irreparable loss, injury and damage to Opposer's business and to the goodwill thereto appertaining as symbolized and recognized by its aforementioned trade symbols.

16. Applicant's alleged mark is a colorable imitation or misappropriation of Opposer's aforementioned trade symbols, and will enable Applicant to reap where it has not sown by trading on the goodwill of Opposer's business as symbolized and recognized by its aforementioned trademarks and other trade symbols.

WHEREFORE, Opposer, by its undersigned attorneys, prays that its opposition to Application Serial No. 76/205,157 be sustained and that the Trademark Trial and Appeal Board grant any and all further relief to Opposer that the Board finds to be necessary and just in the circumstances.

A duplicate copy of this *Notice of Opposition* is enclosed, along with a check for the official filing fee of \$1200. The Commissioner is authorized to charge any other fees required to be paid in connection with this proceeding to Deposit Account No. 20-1439.

Respectfully submitted,

**TRADEMARK & PATENT COUNSELORS
OF AMERICA, P.C.**

Dated: July 25, 2002

By Mark I. Peroff / Keith E. Danish

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